

Al releasing the partial bundles from the at least one gripping element; and placing the partial bundles in a first collection trough of a collection device.

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Please cancel claim 2 without prejudice.

#### Remarks

#### I. INTRODUCTION

Claims 1, 2, and 5 were pending in the application before entry of this Amendment. Claim 1 has been amended and claim 2 has been canceled without prejudice. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the pending claims are allowable, and reconsideration is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

#### II. INFORMATION DISCLOSURE STATEMENT

The Examiner contends that the information disclosure statement filed on September 22, 2000 does not comply with CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in English. Applicants respectfully disagree. Submitted with the Information disclosure statement was an English language version of the feoreign patent office Search Report. Applicants submit that such report fully satisfies the requirement for a concise explanation of the relevance of each non-English patent listed. *See* MPEP 609. Accordingly, Applicants request that the Examiner withdraw the objection to the information disclosure statement dated September 14, 2000 and fully consider the same.

#### III. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,044,438 ("Everhart") in view of U.S. Patent No. 5,927,819 ("Philipp et al."). Claim 1 is the only independent claim set forth by Applicants. This rejection is moot as to claim 2 because the claim has been canceled without prejudice. It is respectfully submitted that Everhart and Philipp et al., whether taken alone or combined, do not render obvious

claim 1 for the following reasons.

Amended claim 1 relates to a method for manufacturing fiber bundles. The method includes transporting a fiber bundle using at least one feed element and cutting the fiber bundle strand into partial bundles. Applicants use the term “cutting” in the context of its meaning, for example, “to divide (a deck of cards) into portions.” Merriam-Webster’s Collegiate Dictionary, Tenth Edition. Thus, the fibers are divided along their lengths and retain their original length as opposed to creating bundles having shorter lengths than the original bundle. The method further includes the step of releasing the partial bundles from the at least one feed element; gripping the partial bundles using at least one gripping element; releasing the partial bundles from the at least one gripping element; and placing the partial bundles in a first collection trough of a collection device. This last step—previously included in claim 2 and now included in claim 1—as explained in the application, indicates that partial bundles are collected until the number of partial bundles is sufficient for a complete bundle. Such is indicated, for example, in the specification, on page 8, line 30, wherein it is explained that “when the required number of partial bundles 10 has been taken up in the collection trough 42, the plate 44 or the collection device 40 is rotated and thus a new collection trough 42’ is released for filling.”

According to the Examiner, Everhart discloses a method including the steps of transporting a fiber bundle using at least one feed element; cutting the fiber bundle strand into partial bundles having a length; and releasing the partial bundles from the at least one feed element. However, as admitted by the Examiner, Everhart does not disclose the step of gripping the partial bundles using at least one gripping element.

The Examiner argues that Philipp et al. include the teaching absent from Everhart. Specifically, the Examiner argues that Philipp et al. teach the use of a gripper to hold and transport a bundle of bristles. The Examiner contends that it would have been obvious to arrive at Applicants’ invention by combining the aforementioned references.

To establish *prima facie* obviousness of a claimed invention, the prior art must teach or suggest all claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The mere fact that reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Moreover, there is no suggestion or motivation to make the proposed modification if the prior art invention being modified is rendered unsatisfactory for its intended purpose (In re Gordon, 733 F.2d 900, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984)), or if the proposed modification or combination would change the principle of operation of the prior art invention being modified. In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

To begin, Applicants respectfully submit that there is no suggestion or motivation to combine the teachings Everhart and Phillip et al. After all, Everhart is directed to an apparatus and method for forming yarn balls. On the other hand, Phillip et al. seem to disclose methods and devices for trimming and rounding bristles used, for example, in tooth brushes. The teachings of Phillip et al. are not even applicable to those of Everhart, and would not—by one skilled in the art—be combined with the teachings of Everhart.

Even if the references are combinable, Applicants respectfully submit that the cutting step disclosed by either Everhart or Phillip et al. does not correspond to the step recited in claim 1 that provides for “cutting the fiber bundle strand into partial bundles.” After all, the term “partial bundle” is used in the present patent application in the sense of a bundle that forms a part of a “complete bundle” that, for example, may be used for the production of a filter for dialysis. Such a complete bundle is formed by a number of partial bundles. Before combining the partial bundles, Applicants’ bundles are merely divided lengthwise. On the other hand, the “pom” that is shown in Everhart is formed by cutting bound lengths of yarn of a certain length into bundles of yarn having shorter lengths than the original. Phillip et al. is directed to trimming and rounding bristles and also has no relation to the separation of fibers as disclosed by Applicants. As such, Everhart and Phillip et al. represent non-analogous art and completely fail to teach or suggest the “cutting” step in the context recited in claim 1 of the application. As such, Applicants respectfully request that this rejection is withdrawn.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Everhart in view of U.S. Patent No. 3,951,022 (“Hurtes”).

With regard to the features of claim 5, the Examiner admits that Everhart fails to teach the step of rotating the collection device after a first collection trough is filled. The Examiner contends that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Everhart’s device with a plurality of rotating collection device [sic] as taught by Hurtes in order to transport only a desired amount of fibers to a subsequent station for further processing.” Applicants respectfully disagree and request reconsideration in light of the amendments and below comments.

Claim 5 recites “rotating the collection device after the first collection trough is filled and placing the partial bundles in a further collection trough.” Such a feature is not taught or suggested by the prior art references—alone or in combination. As mentioned above, the Examiner contends that it would have been obvious “to provide Everhart’s device with a plurality of rotating collection device [sic] as taught by Hurtes.” Yet, Hurtes teaches no such rotating collection device. In fact, even the Examiner expresses as much by stating that “Hurtes teaches a *horizontal advancement means* (12) to accommodate each oriented fibers [sic].” (Emphasis added). Such a horizontal format teaches away from Applicants’ invention. And it is the rotating design of the Applicants’ trough that helps to avert “interruption to the process which would make a discontinuous performance of the total process necessary.” (Specification, page 4, lines 9 and 10). As this feature is neither taught nor suggested by any of the prior art references cited by the Examiner, the rejection of claim 5 is improper. In any event, claim 5 depends from claim 1 and includes all the limitations therefrom. Thus, claim 5 is allowable for at least the same reasons as claim 1.

#### IV. CONCLUSION

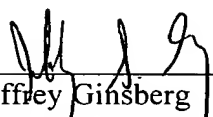
It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Examiner is invited to contact the undersigned at (212) 425-7200 to discuss any matter relating to this application.

The Patent Office is authorized to charge any fees which may be necessary for consideration of this paper to Kenyon & Kenyon Deposit Account No. 11-0600.

Dated: August 15, 2001

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claim 1 has been amended as follows:

1. (Amended) A method for manufacturing fiber bundles comprising:
  - transporting a fiber bundle using at least one feed element;
  - cutting the fiber bundle strand into partial bundles, the partial bundles having a length;
  - releasing the partial bundles from the at least one feed element;
  - gripping the partial bundles using at least one gripping element; [and]
  - releasing the partial bundles from the at least one gripping element; and
  - placing the partial bundles in a first collection trough of a collection device.

Claim 2 has been canceled without prejudice.